

Application No. 10/765,252  
Paper dated May 18, 2006  
PPG Docket No. 1908A1



17w

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/765,252  
Applicant : Thomas G. Rukavina  
Filed : January 27, 2004  
Title : URETHANE POLYOL PRECURSORS  
FOR COATING COMPOSITIONS  
Group Art Unit : 1711  
Examiner : Thao T. Tran

Mail Stop Amendment  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT  
AND ELECTION WITH TRAVERSE**

Sir:

The present communication is submitted in response to the Office Action dated April 18, 2006, issued by the Examiner in connection with the above-referenced application subsequent to Applicant's filing of an Appeal Brief. In view of the following remarks, reconsideration of the restriction is respectfully requested.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on May 18, 2006  
Date

  
Lisa R. McNany

Signature

Typed or Printed Name of Person Signing Certificate

Initially, Applicant thanks the Examiner for withdrawing the previous rejection in view of Applicant's appeal of the rejection and submission of an Appeal Brief. The Examiner, however, has subsequently issued a restriction requirement under 35 U.S.C. §121, restricting the claims between the following two groups:

Group I – Claims 1-9, drawn to a trimeric unsymmetrical polyurethane polyol, and

Group II – Claims 10-23, drawn to a coating composition and a laminate.

Applicant provisionally elects to prosecute the claims of Group I, claims 1-9, with traverse.

Initially, Applicant submits that restriction between these groups of claims at the present stage of prosecution is inappropriate. In particular, the Examiner has previously examined all of these claims together, and Applicant has prosecuted the claims through to Appeal, including the filing of an Appeal Brief. For the Examiner to now consider the claims as drawn to distinct inventions is clearly inappropriate, considering that the claims had been previously considered and examined together.

Moreover, the Examiner indicates that Inventions I and II are unrelated, noting that inventions are considered unrelated if it can be shown that they are not disclosed as capable of use together and if they have different designs, modes of operation and effects. The Examiner contends that the two groups of claims in the present case have different effects because Group I is directed to a trimeric polyol

and Group II is directed to a coating composition comprising a polyol precursor and polyisocyanate.

Such a restriction of the claims is improperly based. As noted, the Action states that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and if they have different designs, modes of operation and effects. In the present case, the Examiner has not shown how the inventions of Group I and Group II are not disclosed as capable of use together. In fact, the Group II claims are specifically directed to a coating composition and substrate including a coating composition, where the coating composition comprises a hydroxy-terminated polyurethane polyol precursor comprising the reaction product of a diisocyanate, an aliphatic diol and a polymeric diol. Such a reaction product is specifically what is claimed in claim 1 as a trimeric unsymmetrical polyurethane polyol. Accordingly, the polyol of the Group I claims is clearly disclosed as being capable of use with the coating composition and coated substrate of the Group II claims and, in fact, is specifically claimed in this manner. Accordingly, restriction between these two groups is improper.

Moreover, it is apparent that searches directed to the claims of either Group I or Group II would clearly overlap each other due to the common subject matter relating to the trimeric polyol. Such coextensive searching would not present any undue burden on the Examiner for examination of the claims. In fact, as the application has previously been prosecuted to the Appeal stage, Applicant assumes that the Examiner has appropriately examined the claims during prior prosecution of the application. In fact, the Examiner has previously searched all of the claims and has rejected the claims in prior prosecution, which previous rejections have been

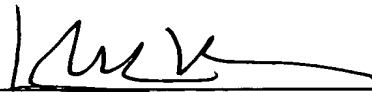
withdrawn. Accordingly, restriction between the allegedly distinct inventions embodied by these groupings of claims is inappropriate.

Finally, Applicant submits that restriction after the final rejection and after withdrawal of the rejection after Appeal places an undue burden on the Applicant in terms of prosecution. Applicant assumes that the prior search of the application by the U.S. Patent and Trademark Office was complete, and that the previous rejections of the claims set forth the most relevant prior art. For the Examiner to now restrict the invention in order to conduct further searching of the claims, particularly when such a restriction would not place an undue burden on the Examiner for additional searching, is inappropriate.

In view of the above remarks, withdrawal of the restriction requirement is respectfully solicited. Should the Examiner have any questions regarding any of this information, the Examiner is invited to contact Applicant's undersigned representative by telephone at 412-471-8815.

Respectfully submitted,

The Webb Law Firm

By \_\_\_\_\_

Kirk M. Miles  
Registration No. 37,891  
700 Koppers Building  
436 Seventh Avenue  
Pittsburgh, PA 15219  
Telephone: 412-471-8815  
Facsimile: 412-471-4094  
webblaw@webblaw.com